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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,253	04/24/2001	Francis Bourrieres	N48 2-9735	3338
490	7590	04/27/2005	EXAMINER	
VIDAS, ARRETT & STEINKRAUS, P.A. 6109 BLUE CIRCLE DRIVE SUITE 2000 MINNETONKA, MN 55343-9185			TRINH, MINH N	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/830,253	<b>Applicant(s)</b> BOURRIERES, FRANCIS	
	<b>Examiner</b> Minh Trinh	<b>Art Unit</b> 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 10-15, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-15, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/02/04</u> . | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

1. The proposed amendment filed on 12/02/2004 has been fully consideration and made of record.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 13-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are examples:

The scope of claim 13-14 is unclear since claims directed to the electronic module as described in the preamble of claims 10-15 and 19-20, however claims 13-15 directed to an associated structural element especially the PCB and combination therefrom (see claim 13, lines 2-6) which makes the scope of it unclear. Further, claim 14 directed to the decoupling capacitor and /or serial resistor, etc. is very confusing because the claims directed to the module manufacturing method which does not require such step of decoupling and it is not known whether the capacitor and resistor are a part of the module since no indication whether these element are parts of the module to be formed. Please clarify.

Regarding claims 13-14. It is noted that no art rejections have been applied to these, since there are a great deal of confusion and uncertainty as to the proper interpretation of the claims limitations. Therefore, it would not be proper to reject such claims on the basis of prior art. See MPEP 2173.06.

5. Claims 10, 13, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acocella et al (US 5,675,889) in view of DE 4326104A1 or DE 19648728A1.

Acocella et al disclose a method for producing an electronic module as recited in the claims of the present invention comprising steps: depositing solder cream 13 on the substrate 11 for connecting to the components and transferring the components to the corresponding mounting lands (see Figs. 4 and 6); the connecting the components to the substrate 11. Acocella et al however do not teach the surface mounted components (SMC) operatively mounted to the substrate and the simultaneously depositing of the solder cream for the surface mounted components. Each one of the DE 4326104A1 or DE 19648728A1 discloses the above techniques (see Figs. 4 of the DE 4326104A1 reference depicts the SMC being mounted on the associated substrate along with the simultaneously placing of solder 3's, etc. Further, the DE 19648728A1 teaches the same as shown in Fig. 3, where the SMC 17 and the simultaneously depositing of the solder cream for the surface mounted components). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the either DE 4326104A1 or DE 19648728A1 teaching as

described above onto the method invention of Acocella et al as so to form a desired module having the ball sphere as housing therefrom.

As applied to claim 13, noting each reference teaches the connecting the module to the PCB. It is noted that the applied references show similar combination therefore it is capable of "producing an electromagnetic shield integrated.. . printed circuit" as recited in claim 13, lines 4-6 of the present invention.

As applied to claim 15, each references shows the module having surface for gripping associated therefrom.

As applied to claim 19, each prior art teaches that the module is being connected to the PCB or substrate ( i.e., see Fig. 3 of the DE 19648728A1 reference).

6. Claims 11-14 and 20 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Acocella et al in view of DE 4326104A1 or DE 19648728A1

Regarding claims 11-12, note that the depositing of soldering cream by serigraphy and/or syringe are old and well known in the art. Therefore, it would have been obvious to one ordinary having skill in the art at the time the invention was made to provide the above teaching into the method invention of Acocella et al for various known benefits including for connecting a substrate onto its associated structure such as PCB, etc. Furthermore, it would have been an obvious matter of design choice to deposit soldering cream by a known techniques i.e., by using serigraphy and/or syringe or the like since applicant has not disclosed that these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with

the screen printing deposit techniques as taught or suggested by the prior art reference (as discussed at col. 4 of Acocella et al).

Regarding claims 13-14 (see paragraph 4 above).

Regarding claim 20, regarding the size if the interconnection being greater in diameter than the height of the components. It would have been an obvious matter of design choice to make the different portions of the interconnection of whatever form or shape was desired or expedient. Since a change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. Moreover, it would have been an obvious matter of design choice to make the size of the interconnection to be greater in diameter than the height of the components since applicant has not disclosed that these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with the size configurations as provided by the prior art reference (see Fig. 4A of the DE 4326104A1 reference)

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 10-15 and 19-20 have been considered but are moot in view of the new ground(s) of rejection.

Amendment to claims 13-14 has not overcome the 112 rejections (see paragraph 4).

### **Interviews After Final**

8. Applicant notes that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing). Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search will be denied. See MPEP 714.13 and 713.09.

### **Conclusion**

9. Please provide numeral references to the claimed limitations as well as support in the disclosure (i.e., page and line numbers and reference number associated with from the drawings) for better clarity. Applicant requires to point out the support for any amendment made to the disclosure and the claims. See 37CFR 1.111 and section 2163.06 of the MPEP.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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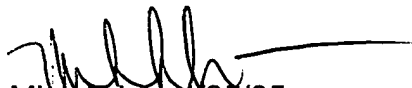
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (571) 272-4569. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mt

  
Minh Trinh 4/25/05  
Primary Examiner